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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,423	04/23/2001	John Carney	007412.01058	5451

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EXAMINER	
KURIEN, CHRISTEN A	

ART UNIT	PAPER NUMBER
2427	

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11/24/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/841,423	CARNEY ET AL.	
	Examiner	Art Unit	
	CHRISTINE KURIEN	2427	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,6,8,13 and 21-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3, 6, 8, 13, and 21-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Miscellaneous

1. Please note that the examiner of record for this application has changed.

Response to Arguments

Applicant's arguments filed 09/16/2010 have been fully considered but they are not persuasive. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the combination of the references teaches the limitations of claim 1. *Eldering* teaches receiving interactive TV content via a first broadcast stream, i.e. receiving content at a head-end from a centralized point (Para. 37, 51, 52); determining if the content is targeted for a specific group of receivers based upon first personalization data (Para. 33-34, 37, 41, 51); and upon determining the content is targeted for the specific group of receivers, transmitting the interactive TV content via a second broadcast stream to the specific group of receivers, i.e. routing the content to the correct node or receiver based upon the assigned group or subgroup (Para. 30, 37,

51-52), the tagged content is taught in Kunkel (i.e. content is tagged with demographic codes Col. 3, lines 35-50). Applicant also argues that Kunkel solely operates at the set top box converter level at the end user for processing to determine the advertisement for display, and that the Kunkel system to exist within the router of Eldering would completely make Kunkel non-operational. Examiner respectfully disagrees, Eldering teaches the targeted advertisements are inserted in the program streams at a centralized distribution such as a router or a cable head-end (Abstract). Kunkel in Fig. 1, clearly teaches a head-end connected to the set-top box converter.

Double Patenting

2. Applicant is advised that should claim 31 be found allowable, claim 32 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, 6, 8, 13, and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunkel (US 7,100,183) in view of Eldering (US2005/0193410).

Regarding claim 1, Kunkel teaches a method for selectively providing personalized interactive TV content comprising (Col. 4, lines 33-64):

broadcasting the interactive TV content via a first broadcast stream, the interactive TV content including tagged content, the tagged content being marked by a tag comprising first personalization data, i.e. content is tagged with demographic codes (Col. 3, lines 35-50);

determining if the tagged content is targeted for a specific group of receivers based upon the first personalization data (Col. 3, line 59-Col. 4, line 24; Col. 6, lines 4-8); and

upon determining the tagged content is targeted for the specific group of receivers, transmitting the interactive TV content via the first broadcast stream to the specific group of receivers, i.e. content is sent to users and filtered based on the demographic codes (Col. 3, line 35-Col. 4, line 24; Col. 6, lines 4-8).

Kunkel does not clearly teach receiving interactive TV content via a first broadcast stream; and transmitting the interactive TV content via a second broadcast stream to the specific group of receivers.

Eldering teaches receiving interactive TV content via a first broadcast stream, i.e. receiving content at a head-end from a centralized point (Para. 37, 51, 52);

determining if the content is targeted for a specific group of receivers based upon first personalization data (Para. 33-34, 37, 41, 51); and

upon determining the content is targeted for the specific group of receivers, transmitting the interactive TV content via a second broadcast stream to the specific group of receivers, i.e. routing the content to the correct node or receiver based upon the assigned group or subgroup (Para. 30, 37, 51-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kunkel to include receiving interactive TV content via a first broadcast stream; and transmitting the interactive TV content via a second broadcast stream to the specific group of receivers, using the known method of routing content based upon assigned groups, as taught by Eldering, in combination with the interactive content tagging system of Kunkel, for the purpose of conserving bandwidth while also providing effective advertising.

Regarding claim 3, Kunkel in view of Eldering teaches selectively broadcasting the second personalization data to the at least one receiver (Kunkel-Col. 3, line 59-Col. 4, line 24).

Regarding claim 6, claim is analyzed with respect to claim 1.

Regarding claim 8, claim is analyzed with respect to claim 3.

Regarding claim 13, claim is analyzed with respect to claim 1. Kunkel in view of Eldering further teaches the tagged content is personalized for display only by one or more receivers provided with respective second personalization data (Kunkel-Col. 3, line 59-Col. 4, line 46; Eldering-Para. 33, 36).

Regarding claim 21, Kunkel in view of Eldering teaches selectively receiving second personalization data by at least one receiver of the specific group of receivers, via a third broadcast stream, the second personalization data including data to permit the at least one receiver to output the tagged content, e.g. demographic information may be downloaded to the set-top box from the head-end (Kunkel-Col. 3, lines 14-28; Col. 3, line 59-Col. 4, line 24).

Regarding claim 22, claim is analyzed with respect to claim 21.

Regarding claim 23, claim is analyzed with respect to claim 21.

Regarding claim 24, *the combination of references* teaches the method of claim 1, wherein the interactive TV content is received via the first broadcast stream from a cable head-end system (Kunkel, Fig 1, label 10, Eldering, Para. 37,51,52)

Regarding claim 25, *the combination of references* teaches the method of claim 24, wherein the receivers of the specific of group of receivers are TV subscriber set-top boxes (Kunkel-Col. 3, lines 14-28; Col. 3, line 59-Col. 4, line 24).

Regarding claim 26, *the combination of references* teaches the method of claim 1, wherein the receivers of the specific of group of receivers are TV subscriber set-top boxes (Kunkel-Col. 3, lines 14-28; Col. 3, line 59-Col. 4, line 24).

Regarding claim 27, claim is analyzed with respect to claim 24.

Regarding claim 28, claim is analyzed with respect to claim 25.

Regarding claim 29, claim is analyzed with respect to claim 26.

Regarding claim 30, claim is analyzed with respect to claim 24.

Regarding claim 31, claim is analyzed with respect to claim 25.

Regarding claim 32, claim is analyzed with respect to claim 26.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE KURIEN whose telephone number is (571)270-5694. The examiner can normally be reached on Mon.-Thurs., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571)272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. K./
Examiner, Art Unit 2427

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427